Application Serial No. 08/819,669

LUD 5253.5 DIV (09885911)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thierry Boon-Falleur et al.

Application No.: 08/819,669

Confirmation No.: 1995

Filed: March 17, 1997

Art Unit: 1644

For: TUMOR REJECTION, ANTIGEN PRECURSORS, TUMOR REJECTION ANTIGEN S AND USES THEREOF

Examiner: P. Gambel

REPLY BRIEF
(37 C.F.R. § 41.41)

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This correspondence is being sent by facsimile to 1-571-273-8300 with a courtesy copy to Eileen O'Hara, SPE and Larry Helms, SPE addressed to: MS Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Eileen Sheffield May 6, 2008

Dear Sir:

This is submitted in response to the Examiner's Answer, dated April 29, 2008

No new amendment, affidavit or other evidence is included herein; however, applicants state on the record that they have in fact filed papers to have a previously filed terminal disclaimer expunged. This point will be discussed further, infra.

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I ERRORS IN THE EXAMINER'S ANSWER

In the discussion of "(5) Summary of Claimed Subject Matter," the Examiner has included a discussion of U.S. Patent No. 5,843,448.

It is submitted that this discussion is not appropriate. The Examiner's function is to determine whether or not the Summary of Claimed Subject Matter is correct, and comment appropriately. It is NOT appropriate to include further discussion of the basis or bases for rejection herein.

The Examiner also states:

> "Further, it is noted that the instant claims do not recite MAGE - 1, -2, -3, -4, -5, -6, -7, -8, -9, -10 nor -11 as described by appellant."

Appellants never said they did. In their own discussion of the "Summary of Claimed Subject Matter" (pages 7-9 of appellants' brief on appeal), they have drawn the Board's attention to species described in the specification which are encompassed by the claims. This is perfectly appropriate, and appellants never asserted that they have claimed what they do not.

The Examiner then goes on to discuss "(6) Grounds of Rejection to be Reviewed on Appeal," and states that appellants statement is correct "except for the following." The Examiner then goes on to discuss issues surrounding the previously filed Terminal Disclaimer.

Appellants do not find this discussion in the appealed from office action. Point 8, of the February 6, 2007 office action states:

> "Claims 183-191 are rejected under 35 U.S.C. § 102(f) or, in the alternative, under 35 U.S.C. 102(f)/103 because the applicants did not invent the claimed subject matter."

As this is the only rejection made in that action, appellants' statement of the Grounds for Rejection to be Reviewed on Appeal" is correct. Indeed, compare (6) and (9) of the Examiner's Answer, and this will be clear.

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II REBUTTAL OF THE EXAMINER'S POSITION

The Examiner's argument appears to begin at page 10, however, rather than address appellants' Brief, the Examiner appears to be reviewing the file history prior to the filing of the Brief, and not the Brief itself. Further, the Examiner makes statements that cannot be seen as directed to arguments made by appellants. For example, the Examiner states:

> "With respect to appellant finding of no distinction in 35 U.S.C. § 102(t) between patent and publications, appellant is reminded that each claim of a U.S. Patent is presumed valid by U.S. courts until proven otherwise."

NOWHERE have appellants challenged the validity of any patent. Rather, in prior actions, appellant cited Exparte Kusko*, 217 USPQ 972 (PTO Bd. App. 1982) which the Examiner dismissed as irrelevant because the Kusko case deals with publications and not patents.

A rejection under 35 U.S.C. § 102(f) is based upon disclosure, not validity of a patent. Appellants cited to Kusko and have argued that 35 U.S.C. § 102(f) makes no distinction between patents and publications because it does not. Hence, case law involving rejections under 35 U.S.C. § 102(f) where a non-patent reference is involved are every bit as relevant as any where a patent is involved. Hence, the Examiner's burden is to show how Kusko does not apply, but as the statute draws no distinction between the two classes of disclosure, arguing "Kusko deals with a paper" is not an adequate distinction. The Examiner has clearly failed to explain why Kusko does not control.

With respect to the statement made by the Examiner that "each case is decided on its own facts," it is submitted that if facts alone controlled determinations, there would be no need for precedents or the citation of cases – hence one wonders why the Examiner feels compelled to cite cases at all.

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* Citation was omitted in appellant Brief and this is regretted.

In any event appellants do believe that facts must be considered, and have presented a detailed discussion of facts, over pages 12-14 of their Brief. The Examiner ignores most of this, ignores precedent, and to the degree that Examiner relies in facts, he distorts them.

For example, it is absolutely true that the '774 patent did issue with an incorrect sequence. However, the claims of the current application were and are fully supported by the specification as filed, with or without the correct sequence. With respect to delays in correcting the sequence, it is suggested that the Examiner admit to the excessive delays caused by the USPTO in making the correction.

While the Examiner is in fact correct that the application leading to 448 was filed prior to the correction of the sequence, he also conveniently ignores the following: the reissue application to correct the sequence was filed on January 24, 1996 – more than 2 years before the application leading to the '448 patent was filed. The Examiner's recitation of facts is incomplete.

The discussion presented by the Examiner at pages 9-10 while interesting, does not discuss application of 35 U.S.C. § 102(f), as per appellants' discussion. Nothing presented in the Examiner's Answer rebuts appellants' argument.

The Examiner seems to be taking the position that, because a terminal disclaimer was filed in response to an improper obviousness type double patenting rejection, a 35 U.S.C. § 102(f) rejection' is de facto proper. The rationale for this point of view escapes appellants. Appellants admit that they did not recognize the error in co-ownership and regret it; however, filing an incorrect terminal disclaimer is NOT an admission that 35 U.S.C. § 102(f) applies.

Appellants must also take issue with the Examiner's bald faced misrepresentation regarding inventorship. The Examiner asserts that attempts to correct inventorship were not made until over 8 years after the '448 patent issued.

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Actually, as appellants pointed out in their December 12, 2006 submission, correction attempts were made on:

August 7, 1996,
October 19, 1998,
November 23, 1998.

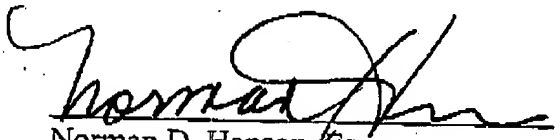
The USPTO acted on NONE of these. When this was brought to the Examiner's attention, his response was cryptic, to say the least. Please see the office action of February 6, 2007, at pages 3-4.

In short, the Examiner's Answer is filled with incomplete and misstatements of the facts, and does not address any of the solvent issues raised by appellant. As such appellants previously submitted Brief is believed to be convincing of Examiner error, and the rejection should be REVERSED.

As a courtesy, appellants are sending copies of this Reply Brief to conferees Eileen O'Hara and Larry Helms.

Respectfully submitted,

FULBRIGHT & JAWORSKI, L.L.P.



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